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REMARKS

Claims 16-21, 27 and 28 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

In the Office Action, the drawings have been objected to, because, according to the Office Action, they do not show a closure member for each input and a biasing member for each closure member. However, Applicant submits that an input for each closure member and a biasing member for each closure member is clearly shown in Fig. 4. Furthermore, Applicant submits that the drawings are clearly acceptable under 37 C.F.R. §1.83(b). Accordingly, Applicant respectfully requests withdrawal of the objection to the drawings.

Claims 2-8 and 19 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has canceled claims 2-8 and submits that the rejection of these claims is therefore moot. In regard to claim 19, Applicant has amended the claims to state that each sleeve of the diaphragm includes one of the cups to thereby make clear that the cups in claim 19 are the same as the cups in claim 18. Accordingly, Applicant submits that claim 19 is definite.

Claims 2-27 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,001,541 to St. Clair. Claims 2-15 and 22-26 have been canceled from the present application such that the only outstanding rejection of the claims as being anticipated by the St. Clair '541 patent is in regard to claims 16-21 and 27. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of anticipation based upon the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Applicant respectfully asserts that the Examiner has not yet met his burden of establishing a prima facie case of anticipation with respect to the rejected claims.

Claim 16 defines a pressure regulator comprising a housing having an interior space, at least one input into the interior space and an output out of the interior space. The housing is

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configured to have a fluid enter into the interior space through the at least one input and exit the interior space through the output. The housing has a first portion and a second portion. A closure member for each input selectively covers an associated one of the at least one input for preventing fluid flow into the interior space of the housing. A diaphragm in the housing includes a periphery captured between the first portion of the housing and the second portion of the housing. The diaphragm is interconnected to the closure member. A biasing member for each closure member is configured to selectively bias the closure member away from the associated one of the at least one input to allow fluid flow through the input. The diaphragm is configured to move against the biasing member when pressure in the interior space is above a predetermined amount, whereby the closure member will move in response to movement of the diaphragm to close the at least one input such that fluid is not able to pass into the interior space through the input. The diaphragm includes a pair of sleeves, each sleeve having a rolling receiver portion receiving one of the biasing members therein, the diaphragm includes a substantially planar flat surface portion located interior of the periphery of the diaphragm captured between the first portion of the housing and the second portion of the housing, the planar flat portion surrounding the sleeves and being located between the sleeves, whereby the rolling receiver portions can move with movement of the biasing members without substantially moving the substantially planar flat surface portion.

Applicant submits that the prior art of record does not disclose or suggest the above noted features of claim 16. Specifically, Applicant submits that the St. Clair '541 patent does not disclose a diaphragm including a substantially planar flat portion surrounding a pair of sleeves and being located within sleeves, with each sleeve having a rolling receiver portion receiving a biasing member therein, along with the remaining features of claim 16. Applicant submits that the St. Clair '541 patent does not disclose any such diaphragm. Notably, it appears that the Office Action states that the St. Clair '541 patent does not include any such diaphragm as the St. Clair '541 patent has been combined with U.S. Patent No. 2,380,956 to Evarts to reject claim 16. Accordingly, Applicant submits that claim 16 is in condition for allowance. Furthermore, claims 17-21, 27 and 28 depend from claim 16, and since claim 16

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defines patentable subject matter as discussed above, claims 17-21, 27 and 28 define patentable subject matter.

Claims 5, 11, 12 and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the St. Clair '541 patent in view of the Evarts '956 patent. Claims 5, 11 and 12 have been canceled such that the only outstanding rejection of the claims over the St. Clair '541 patent and the Evarts '956 patent applies to claim 16. As further discussed below, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The test for obviousness has recently been addressed by the U.S. Supreme Court in *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). In its decision, the Supreme Court stated that the teaching-suggestion-motivation (TSM) standard developed by the Federal Circuit was no longer the sole test for determining obviousness. Nevertheless, the Court indicated that the TSM test provides helpful insights as to the obviousness of the invention. With respect to the TSM test, the U.S. Patent and Trademark Office, which had adopted that test, set forth the requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. ***Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.***

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [emphasis added]

The U.S. Supreme Court held that the TSM standard was not the sole standard for finding obviousness, one element to the finding of a *prima facie* case of obviousness is common to both the TSM standard and the standards that may otherwise fall within the per view of the *KSR* decision. Specifically, each and every element of the claimed invention must still be found in the prior art. As will be set forth below, there are elements of the claimed invention that are missing in their entirety from the cited prior art.

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Further, with respect to the recent Supreme Court decision in *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), the Deputy Commissioner for Patent Operations has issued a memo advising the examiners that "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."

Applicant submits that claim 16 is not obvious over the prior art of record. First, Applicant submits that it is not obvious to place any diaphragm of the Evarts '956 patent with the assembly of the St. Clair '541 patent as the diaphragm of the Evarts '956 patent would prevent or obstruct movement of the thimble sections 29 and 30 and the heads 51 and 61. Accordingly, Applicant submits that the diaphragm of the Evarts '956 patent would not work in the assembly of the St. Clair '541 patent. Furthermore, such a change would not alter the St. Clair '541 patent such that Applicant submits that there is no motivation for making any such change. Nevertheless, even if it was obvious to combine the references as set forth in the Office Action, Applicant submits that any resulting combination would not include all of the features of claim 16. Specifically, any such combination would not include a diaphragm including a pair of sleeves, with each sleeve having a rolling receiver portion receiving one of the biasing members therein, the diaphragm including a substantially planar flat surface portion located interior of the periphery of the diaphragm captured between a first portion of the housing and a second portion of the housing, with the planar flat portion surrounding the sleeves and being located between the sleeves, whereby the rolling receiver portions can move with movement of the biasing members without substantially moving the substantially planar flat surface portion, along with the remaining features of claim 16. Applicant submits that a combination of the references will not include any such diaphragm as claimed. Accordingly, claim 16 is in condition for allowance.

Claims 17-21, 27 and 28 depend from claim 16, and since claim 16 defines patentable subject matter as discussed above, claims 17-21, 27 and 28 define patentable subject matter. Furthermore, in regard to claim 28, the prior art of record does not disclose a diaphragm as claimed in claim 16 wherein a transition between the substantially flat planar surface portion

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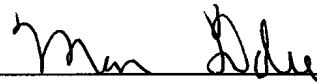
and the sleeves is substantially perpendicular. Accordingly, claims 17-21, 27 and 28 are in condition for allowance.

All pending claims 16-21, 27 and 28 are believed to be in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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Date



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